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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,654	08/30/2000	Satoshi Yashiro	CANO:013	2191

7590 09/29/2005  
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EXAMINER

ALI, MOHAMMAD

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/651,654

Applicant(s)

YASHIRO, SATOSHI

Examiner

Mohammad Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-9,12-15 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-9,12-15 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

AT

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/25/05 has been entered.
2. The application has been examined and claims 1-3, 6-9, 12-15 and 18-21 are pending in this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recite the limitation "search method" in claim. There is insufficient antecedent basis for this limitation in the claim (e.g, examiner suggestions computer-implemented).

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**MPEP 2106 IV.B.2.(b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claim 20, in view of the above-cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

These claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. The use of a computer is not evident in the claim. MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6-9, 12-15 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshitaka Sano ('Sano' hereinafter), US Patent 5,038,379 in view of Jones et al. ('Jones' hereinafter), USP 6,415,302.

With respect to claim 1,

Sano discloses the claimed invention including, an image search apparatus (col. 1, lines 10-15) comprising:

reffering means for reffering to a keyword table in a memory (information representative of the kind of image, character pattern is photographed in the first image 10 and the key word or the like is read and analyzed until the electronic micro reader detects the right end of the image, thereby producing the key word (search information) to search the image or a series of subsequent images. This search information is loaded into the first memory (or disk file 11 "table") together with the image information to be searched, see col. 5, lines 45-55, Sano), wherein the keyword table includes a keyword that corresponds to a plurality of different images (image information including discriminating information to discriminate the image "different" information or a plurality of image information of the same group from another image information, see col. 2, lines 58-61, Sano) and a plurality of levels of importance of the keyword with respect to said plurality of images as (col. 2, lines 1-8, et seq);

search means for searching said plurality different images according to an input search query related to the keyword is taught by Sano as search in the image information inputted from an image inputting apparatus and thereby to produce the search information to search desired image information in consideration (col. 1, lines 58-62);

acquiring means for acquiring said plurality of levels of importance of the keyword based on the images searched by said search means (enable the key word to be changed to the key word that can be easily searched by the user, a check is made in step S8 to see if the correction of the search information is instructed from the keyboard or not, see col. 5, lines 26-29, Sano); and

outputting means for outputting the said plurality of images searched by said search means in an order according to said plurality of levels of importance of the keyword acquired by said acquiring means is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 58-61 et seq).

Sano does not explicitly indicate "levels of importance".

Jones discloses the levels of importance (selecting the next story icon displays, in clear text format, the story with the next, level of importance on the page, see col. 11, lines 52-60, Jones).

It would have been obvious to one ordinary skill in the image processing art at the time of the present invention to combine the teachings of the cited references, because

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the levels importance of Jones' teachings would have allowed Sano's system provides for simultaneous display of graphical representation of a printed publication , as suggested by Jones at col. 1, lines 16-18, Jones. Further, levels of importance as taught by Jones improves to generates information to display from an input publication files (see col. 3, lines 42-45, Jones).

As to claim 2,

'wherein said output means output,...' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 58-61 et seq).

As to claim 3,

wherein said acquiring means for acquires said accordance,..... (col. 1, lines 45-53 et seq); and

'output means for outputs said plurality of images,....' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 45-61, col. 1, lines 58-67, et seq).

As to claim 6,

'wherein said image search,...' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image

information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 58-61 et seq).

Sano does not explicitly indicate "HTML format".

Jones discloses the levels of importance (see col. 11, lines 23-25, Jones).

It would have been obvious to one ordinary skill in the image processing art at the time of the present invention to combine the teachings of the cited references, because the HTML format of Jones' teachings would have allowed Sano's system provides for simultaneous display of graphical representation of a printed publication , as suggested by Jones at col. 1, lines 16-18, Jones.

With respect to claim 7,

Sano discloses an image search method,... (col. 1, lines 10-15) comprising:

reffering controlling step for reffering to a keyword table in a memory (information representative of the kind of image, character pattern is photographed in the first image 10 and the key word or the like is read and analyzed until the electronic micro reader detects the right end of the image, thereby producing the key word (search information) to search the image or a series of subsequent images. This search information is loaded into the first memory (or disk file 11 "table") together with the image information to be searched, see col. 5, lines 45-55, Sano), wherein the keyword table includes a keyword that corresponds to a plurality of different images (image information including discriminating information to discriminate the image "different" information or a plurality of image information of the same group from another image information, see col. 2,



lines 58-61, Sano) and a plurality of levels of importance of the keyword with respect to said plurality of different images as (col. 2, lines 1-8, et seq);

a searching step of searching said plurality of different images according to an input search query related (enable the key word to be changed to the key word that can be easily searched by the user, a check is made in step S8 to see if the correction of the search information is instructed from the keyboard or not, see col. 5, lines 26-29) to the keyword is taught by Sano as search in the image information inputted from an image inputting apparatus and thereby to produce the search information to search desired image information in consideration (col. 1, lines 58-62);

an acquiring step for acquiring said plurality of levels of importance of the keyword based on the images searched by said acquiring step as (col. 2, lines 454-53, Sano);  
and

an output means for outputting the said plurality of images searched by said search means in an order according to said plurality of levels of importance of the keyword acquired by said acquiring step is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 58-61 et seq).

Sano does not explicitly indicate "levels of importance".

Jones discloses the levels of importance (selecting the next story icon displays, in clear text format, the story with the next, level of importance on the page, see col. 11, lines 52-60, Jones).

It would have been obvious to one ordinary skill in the image processing art at the time of the present invention to combine the teachings of the cited references, because the levels importance of Jones' teachings would have allowed Sano's system provides for simultaneous display of graphical representation of a printed publication , as suggested by Jones at col. 1, lines 16-18, Jones. Further, levels of importance as taught by Jones improves to generates information to display from an input publication files (see col. 3, lines 42-45, Jones).

As to claim 8,

'wherein image data output,... ' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 58-61 et seq).

As to claim 9,

wherein said acquiring means for acquires said accordance,..... (col. 1, lines 45-53 et seq); and

'output means for outputs said plurality of images,....' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 45-61, col. 1, lines 58-67, et seq).

As to claim 12,

'wherein said input step comprises receiving a search query,...' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group from another image information (col. 2, lines 58-61 et seq).

Sano does not explicitly indicate "HTML format".

Jones discloses the levels of importance (see col. 11, lines 23-25, Jones).

It would have been obvious to one ordinary skill in the image processing art at the time of the present invention to combine the teachings of the cited references, because the HTML format of Jones' teachings would have allowed Sano's system provides for simultaneous display of graphical representation of a printed publication , as suggested by Jones at col. 1, lines 16-18, Jones.

With respect to claim 13,

Sano discloses the claimed invention including, a storage medium that can be read by,... comprising instructions for (col. 1, lines 10-15):

'referring keyword table in a memory (information representative of the kind of image, character pattern is photographed in the first image 10 and the key word or the like is read and analyzed until the electronic micro reader detects the right end of the image, thereby producing the key word (search information) to search the image or a series of subsequent images. This search information is loaded into the first memory (or disk file 11 "table") together with the image information to be searched, see col. 5, lines 45-55, Sano), wherein the keyword table includes a keyword that corresponds to a plurality of different images (image information including discriminating information to

discriminate the image “different” information or a plurality of image information of the same group from another image information, see col. 2, lines 58-61, Sano) and a plurality of levels of importance of the keyword with respect to said plurality of different images’ as (col. 2, lines 1-8, et seq);

‘searching said plurality of different images according to an input search query related (enable the key word to be changed to the key word that can be easily searched by the user, a check is made in step S8 to see if the correction of the search information is instructed from the keyboard or not, see col. 5, lines 26-29, Sano) to the keyword’ is taught by Sano as search in the image information inputted from an image inputting apparatus and thereby to produce the search information to search desired image information in consideration (col. 1, lines 58-62);

‘acquiring said plurality of levels of importance of the keyword based on the images searched by said searching instruction’ as (col. 2, lines 454-53, Sano); and

‘outputting means for outputting the said plurality of images searched by said search means in an order according to said plurality of levels of importance of the keyword acquired by said acquiring instruction’ is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 58-61 et seq).

Sano does not explicitly indicate “levels of importance”.

Jones discloses the levels of importance (selecting the next story icon displays, in clear text format, the story with the next, level of importance on the page, see col. 11, lines 52-60, Jones).

It would have been obvious to one ordinary skill in the image processing art at the time of the present invention to combine the teachings of the cited references, because the levels importance of Jones' teachings would have allowed Sano's system provides for simultaneous display of graphical representation of a printed publication , as suggested by Jones at col. 1, lines 16-18, Jones. Further, levels of importance as taught by Jones improves to generates information to display from an input publication files (see col. 3, lines 42-45, Jones).

As to claim 14,

'wherein plurality of images,...' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 58-61 et seq).

As to claim 15,

wherein said acquiring means for acquires said accordance,..... (col. 1, lines 45-53 et seq); and

'output means for outputs said plurality of images,...' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group

(rearranging) from another image information (col. 2, lines 45-61, col. 1, lines 58-67, et seq).

As to claim 18,

'wherein said image search,...' is taught by Sano as the desired keyword for this image information including discriminating information to discriminate the image information for a plurality of image information of the same group (rearranging) from another image information (col. 2, lines 58-61 et seq).

Sano does not explicitly indicate "HTML format".

Jones discloses the levels of importance (see col. 11, lines 23-25, Jones).

It would have been obvious to one ordinary skill in the image processing art at the time of the present invention to combine the teachings of the cited references, because the HTML format of Jones' teachings would have allowed Sano's system provides for simultaneous display of graphical representation of a printed publication , as suggested by Jones at col. 1, lines 16-18, Jones.

Claims 19-21 have the same subject matter as of claims 1, 7, and 13 and essentially rejected for the same reasons as discussed above.

### ***Remarks***

7. Different images taught by Sano as, image information including discriminating information to discriminate the image "different" information or a plurality of image information of the same group from another image information, see col. 2, lines 58-61.

Referring to a keyword table in a memory taught by Sano as, information representative of the kind of image, character pattern is photographed in the first image

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10 and the key word or the like is read and analyzed until the electronic micro reader detects the right end of the image, thereby producing the key word (search information) to search the image or a series of subsequent images. This search information is loaded into the first memory (or disk file 11 "table") together with the image information to be searched, see col. 5, lines 45-55.

Searching the different images according to an input search query related taught by Sano as, enable the key word to be changed to the key word that can be easily searched by the user, a check is made in step S8 to see if the correction of the search information is instructed from the keyboard or not, see col. 5, lines 26-29.

Levels of importance taught by Jones as, selecting the next story icon displays, in clear text format, the story with the next, level of importance on the page, see col. 11, lines 52-60, Jones. It would have been obvious to one ordinary skill in the image processing art at the time of the present invention to combine the teachings of the cited references, because the HTML format of Jones' teachings would have allowed Sano's system provides for simultaneous display of graphical representation of a printed publication , as suggested by Jones at col. 1, lines 16-18, Jones.

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (571) 272-4105. The examiner can normally be reached on Monday-Thursday (7:30 am-6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mohammad Ali  
Primary Examiner  
Art Unit 2167

MA  
September 24, 2005